

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS W. DROOG, STEPHEN A. WITHTINGTON
and DOUGLAS GREENING

Appeal 2007-0062
Application 10/706,797¹
Technology Center 3700

Decided: August 31, 2007

Before ADRIENE LEPIANE HANLON, SALLY C. MEDLEY, and
JAMES T. MOORE *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION ON APPEAL

1 **A. Statement of the Case**

2 Applicants appeal under 35 U.S.C. § 134 from a final rejection of
3 claims 48-51 and 58-60. We have jurisdiction under 35 U.S.C. § 6(b).

1 Application for patent filed 12 November 2003. The real party in interest is Boss Packaging Inc.

Appeal 2007-0062
Application 10/706,797

1 The prior art relied upon by the Examiner in rejecting the claims on
2 appeal is:

3 Gates US 6,550,226 Apr. 22, 2003

4

5 Claims 48-51 and 58-60 stand rejected under 35 U.S.C. § 112, first
6 paragraph, as failing to comply with the written description requirement
7 (Final Rejection 2 and Answer 3).

8 Claims 48-51 and 58-60 stand rejected under 35 U.S.C. § 102(a) as
9 being anticipated by Gates (Final Rejection 3 and Answer 4).

10 B. Issue

11 The first issue before us is whether Applicants have shown that the
12 Examiner erred in determining claims 48-51 and 58-60 to be unpatentable
13 under 35 U.S.C. § 112, first paragraph.

14 The second issue before us is whether Applicants have shown that the
15 Examiner erred in determining claims 48-51 and 58-60 to be unpatentable
16 under 35 U.S.C. § 102(a) as being anticipated by Gates.

17 **C. Findings of fact (“FF”)**

18 The record supports the following findings of fact as well as any other
19 findings of fact set forth in this opinion by at least a preponderance of the
20 evidence.

21 1. Applicants' claims 48-51 and 58-60 are the subject of this appeal.

1 2. Applicants copied claims 20-23 and 30-32 of the Gates patent and
2 presented them as claims 48-51 and 58-60 for purposes of provoking an
3 interference.

4 3. Independent claims 48 and 58 are as follows:

5 48. A method of filling a bag with a material and sealing a bag;
6 the method comprising the steps of:

7 (a) providing an empty collapsed bag on a bag holder;
8 (b) opening the bag;
9 (c) filling the bag with material;
10 (d) grasping the opposed top edges of the bag with a pair of
11 grabber arms;

12 (e) pulling the grasped top edges of the bag apart;
13 (f) delivering the bag to a sealing apparatus; and
14 (g) sealing the bag,

15 wherein step (f) includes the steps of providing a pair of finger
16 assemblies and moving the finger assemblies up, over, and down over
17 the top edges of the bag.

18 58. A method of filling a bag with a material and sealing a bag;
19 the method comprising the steps of:

20 (a) providing an empty collapsed bag on a bag holder;
21 (b) filling the bag with material;

- (c) grasping the opposed top edges of the bag with a pair of finger assemblies that move inwardly and down to grasp the top edges of the bag, the motion being with respect to the bag;
- (d) delivering the bag to a sealing apparatus; and
- (e) sealing the bag.

The Examiner's Findings

7 4. The Examiner found that Applicants' specification does not provide
8 written description support for, among other things, the steps of "providing a
9 pair of finger assemblies and moving the finger assemblies up, over, and
10 down over the top edges of the bag" as recited per independent claim 48
11 (Final Rejection 3 and Answer 3).

12 5. Specifically, the Examiner found that the delivering step only
13 includes moving the finger assemblies laterally, directing attention to the
14 portion of the Specification (14:3-5) that states: "The gripper assembly 50
15 then retracts laterally, as seen in Figure 7(i), and transfers the bag 46
16 longitudinally to the conveyor station 54." (Final Rejection 4).

17 6. The Examiner found that Applicants' specification does not provide
18 written description support for, among other things, "grasping the opposed
19 top edges of the bag with a pair of finger assemblies that move inwardly and
20 down to grasp the top edges of the bag" as recited in independent claim 58
21 (Final Rejection 3 and Answer 3).

22 7. Specifically, the Examiner found that the specification (11:14-31)
23 describes “that the fingers assemblies are fixedly mounted to the gripper

1 assembly 50 and that only the inner fingers 67 move outwardly from each
2 other to meet the respective outer fingers 62 to clampingly engage a bag 46”
3 (Final Rejection 5).

4 Applicants' Arguments

5 8. With respect to claim 48, Applicants argue² that the gripper
6 assembly is capable of moving in three axes (Br. 10) and that (Br. 11):

7 It is clear that the gripper assembly 50 cannot advance
8 laterally and subsequently downwardly on a continuous basis
9 and that upward movement of the gripper assembly (e.g. the
10 arms 62, 66 and fingers 64, 67) must be completed during the
11 cycle. That is, it would be clear to a person skilled in the art that
12 the bag gripper assembly 50 would in fact advance *laterally*
13 towards the hopper 28 subsequently *downwardly*, such that the
14 fingers 64, 67 of both the inner 62 and the other arms 66 of the
15 gripper assembly 50 grasp the bag 46, laterally withdraw the bag
16 46 from the area below the hopper 28 before transferring the bag
17 46 to the conveyor station 120 and subsequently moving
18 *upwardly* into position for the next bag 46. (Emphasis by
19 Applicants).

20

21 9. The Examiner responded and found that (Answer 5):

22 Appellants' gripper assembly being capable of moving in three
23 axis does not justify for the motion of the fingers in transferring
24 the bag to the sealing apparatus as claimed in step (f) of claim
25 48. The Board is respectfully directed to the last paragraph on
26 page 11 of the Brief, in which appellants have admitted that the
27 gripper assembly 50 moving upward into position for the next
28 bag is performed after the bag has been delivered to the sealing

2 We refer to the 10 August 2005 “Substitute Brief on Appeal.”

apparatus. Thus the specification and the drawings do not support the claimed steps of “... *moving the fingers assemblies up, over, and down over the top edges of the bag*” in delivering the bag to a sealing apparatus as claimed in claim 48. (Emphasis by the Examiner).

10. With respect to claim 58, Applicants argue that (Br. 16):

[T]he text clearly supports three axis of movement for the gripper assembly The movement of the gripper assembly 50 results in the finger assemblies 64, 67 moving inwardly (laterally towards the hopper 28) and downwardly such that the fingers 64, 67 extend into the bag 46.

11. The Examiner responded and found that (Answer 6):

With respect to claim 58, the specification does not disclose or support “a pair of finger assemblies that move inwardly and down to grasp the top edges of the bag” recited in claim 58 because the specification at page 11, lines 14-31, teaches that the fingers assemblies are fixedly mounted to the gripper assembly 50 and that only the inner fingers 67 move outwardly from each other to meet the respective outer fingers 62 to clampingly engage a bag 46.

D. Principles of Law

Adequate written description means that, in the specification, the applicant must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the [claimed] invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

“A person shall be entitled to a patent unlessthe invention was

1 known or used by others in this country, or patented or described in a printed
2 publication in this or a foreign country, before the invention thereof by
3 applicant for patent.” 35 USC § 102(a).

4 **E. Analysis**

5 **Claim 48**

6 Claim 48 recites the step of delivering the bag to a sealing apparatus.
7 That step “includes the steps of providing a pair of finger assemblies and
8 moving the finger assemblies up, over, and down over the top edges of the
9 bag.” Thus, claim 48 requires that the steps of providing a pair of finger
10 assemblies and moving the finger assemblies up, over, and down over the top
11 edges of the bag be performed *during the step of delivering the bag to the*
12 *sealing apparatus*. See step (f) of claim 48.

13 The Examiner found that the steps of providing a pair of finger
14 assemblies and moving the finger assemblies up, over, and down over the top
15 edges of the bag during the step of delivering are lacking (FFs 4-5).
16 Applicants have failed to sufficiently demonstrate error in the Examiner’s
17 findings.

18 Applicants’ argument (FF 8) that one of ordinary skill in the art would
19 understand that the bag gripper assembly 50 would laterally withdraw the bag
20 46 from the area below the hopper 28 before transferring the bag 46 to the
21 conveyor station 120 and subsequently move upwardly into position for the
22 next bag 46 is not supported by record evidence and based solely on attorney
23 argument. We will not credit Applicants’ unsupported argument. *Rohm &*

Appeal 2007-0062
Application 10/706,797

1 *Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462
2 (Fed. Cir. 1997) (Nothing in the rules or in jurisprudence requires trier of fact
3 to credit unsupported or conclusory assertions).

4 Moreover, and as pointed out by the Examiner (FF 9), Applicants'
5 argument is not persuasive. Claim 48 requires that the finger assemblies
6 move up, over, and down over the top edges of the bag *during the delivery*
7 *step*. The step of the gripper assembly moving laterally to withdraw the bag
8 from below the hopper is the only movement identified by Applicants that
9 occurs during the delivery step. The subsequent movement upwardly into
10 position for the next bag is done *after the previous bag has been delivered to*
11 *the sealing apparatus*, and is not part of the delivery step. For these reasons,
12 we sustain the Examiner's rejection of claim 48.

13 Since we have determined that Applicants do not have written
14 description support for "the steps of providing a pair of finger assemblies and
15 moving the finger assemblies up, over, and down over the top edges of the
16 bag," we need not determine whether the other terms that the Examiner has
17 identified as lacking written description support for claim 48 are not
18 supported. Moreover, we need not decide whether the rejection of claims 49-
19 51, which depend from claim 48, should be sustained on the basis that certain
20 claim terms of those claims lack written description support. Claims 49-51
21 stand or fall together with claim 48, and as claim 48 lacks written descriptive
22 support, so do claims 49-51. For these reasons, the Examiner's rejection of
23 claims 48-51 is sustained.

1 Claim 58

2 Claim 58 recites the step of “grasping the opposed top edges of the bag
3 with a pair of finger assemblies that move inwardly and down to grasp the
4 top edges of the bag, the motion being with respect to the bag.” The
5 Examiner found that the steps of providing a pair of finger assemblies that
6 move inwardly and down to grasp the top edges of the bag lacks support in
7 the specification, since the specification at page 11, lines 14-31, teaches that
8 the finger assemblies are fixedly mounted to the gripper assembly 50 and that
9 only the inner fingers 67 move outwardly from each other to meet the
10 respective outer fingers 62 (FFs 6-7).

11 Applicants’ annotated claim chart indicates that the finger assembly is
12 shown as items 64 and 67 (Fig. 3) (Br. 15). Thus, the “pair of finger
13 assemblies” includes two fingers 64 and 67 on one side of the bag (also
14 shown for example attached to fixed arm 62(a) and moveable inner arm 66(a)
15 of Fig. 7(h)) and two fingers 64 and 67 on the other side of the bag (also
16 shown for example, as attached to fixed arm 62(b) and moveable inner arm
17 66(b) of Fig. 7(h)). As seen in Figs. 7(a)-7(h), in order for the finger
18 assemblies to “grasp the top edges of the bag,” the inner fingers attached to
19 the moveable inner arms 66(a) and 66(b) must move outward towards the
20 fixed fingers. Thus, the movement of the finger assemblies is not inwardly
21 and down to grasp the top edges of the bag – the inner fingers move
22 outwardly in order to grasp the bag.

Appeal 2007-0062
Application 10/706,797

1 Applicants' argument that the movement of the finger assemblies 64,
2 67 moving inwardly (laterally towards the hopper 28) and downwardly such
3 that the fingers 64, 67 extend into the bag 46 is not persuasive. Only inner
4 fingers 64 extend into the bag. Moreover, the motion of moving inwardly
5 towards the hopper (towards the bag) and downwardly does not result in
6 "grasping the opposed top edges of the bag with a pair of finger assemblies
7 that move inwardly and down *to grasp the top edges of the bag.*" It is only
8 until the inner fingers are moved outwardly towards the fixed fingers do the
9 fingers grasp the top edges of the bag.

10 For these reasons, we sustain the Examiner's rejection of claim 58.
11 We need not decide whether the rejection of claims 59 and 60, which depend
12 from claim 58, should be sustained on the basis that certain claim terms of
13 claims 59 and 60 lack written description support. Claims 59 and 60 stand or
14 fall together with claim 58, and in so much as claim 58 lacks written
15 descriptive support, so do claims 59 and 60. For these reasons, the
16 Examiner's rejection of claims 58-60 is sustained.

17 102(a) rejection

18 The Examiner rejected claims 48-51 and 58-60 as being clearly
19 anticipated by Gates under 35 U.S.C. 102(a) (Final Rejection 3 and Answer
20 4). Gates was published April 22, 2003 and the instant application was filed
21 November 12, 2003. The Examiner found that since Applicants do not have
22 written description support for the claim terms, the claims constitute new

Appeal 2007-0062
Application 10/706,797

1 matter and are also not entitled to the benefit of any of their earlier filed
2 applications³.

3 In response, Applicants' argue that they do have support for the
4 claimed terms (Br. 17-18). As outlined above, Applicants have failed to
5 demonstrate error in the Examiner's rejections. Applicants also argue that
6 since the Examiner has "determined that the inventions are separate and
7 distinct [he] cannot ignore the plain meaning of the statute in order to serve
8 the Examiner's opinion for rejection of the claims" (Br. 18). It is difficult to
9 understand Applicants' argument. Based on the record before us, the
10 Examiner has made no determination that the claimed "inventions are
11 separate and distinct." The Examiner determined that Applicants' claims 48-
12 51 and 58-60, which are identical to Gates claims 20-23 and 30-32
13 respectively, are not supported by Applicants' specification. Based on the
14 record before us, Applicants have failed to demonstrate error in the
15 Examiner's rejection. For these reasons, we sustain the Examiner's rejection
16 of claims 48-51 and 58-60 as being clearly anticipated by Gates.

3 Application 10/706,797 claims the benefit of, and is said to be a divisional of application 09/890,083, filed 25 July 2001, which is said to be a national stage entry of PCT/CA00/00114, filed 7 February 2000. Applicants also claim the benefit of Canadian Application No. 2,262,276, filed 15 February 1999.

Appeal 2007-0062
Application 10/706,797

1 **E. Decision**

2 Upon consideration of the record, and for the reasons given, the
3 Examiner's rejections are affirmed.

4 The Examiner's rejection of claims 48-51 and 58-60 as being
5 unpatentable under 35 U.S.C. § 112, first paragraph is affirmed.

6 The Examiner's rejection of claims 48-51 and 58-60 as being
7 anticipated under 35 U.S.C. 102(a) by Gates is affirmed.

8

AFFIRMED

hlj

cc:

Collard & Roe
1077 Northern Boulevard
Roslyn, NY 11576